

## **REMARKS**

The non-final office action of November 24, 2010 has been carefully reviewed and this paper is in response thereto. Claim 38 has been amended herein to correct a typographical error. No new matter has been added. In the office action, the claims are rejected as follows.

- Claims 25, 28, 36, and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Butler (US 2001/0007493), in view of Lightbody (US 5,471,577).
- Claim 26 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Butler, in view of Lightbody, and in view of Enomoto et al (US 6,367,080 B1).
- Claims 27 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Butler, in view of Lightbody, and in view of Gerace (US 5,848,396).
- Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Butler, in view of Lightbody, in view of Gerace, and in view of Shoff (US 2005/0015815 A1).
- Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Butler, in view of Lightbody, and in view of Kikinis (US 6,205,485 B1).
- Claim 35 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Butler, in view of Lightbody, and in view of Yagawa et al (US 2004/0172661).
- Claims 1-2, 7-8, 10-11, 13, 15-16, 18-21, and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thrift (US 6,510,557 B1), in view of Enomoto, and in view of Lightbody.
- Claims 7, 32, and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thrift, in view of Enomoto, in view of Lightbody, and in view of Butler.
- Claims 14 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thrift, in view of Enomoto, in view of Lightbody, and in view of Kikinis.
- Claims 31 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thrift, in view of Enomoto, in view of Lightbody, and in view of Yagawa.

### **Kikinis, Thrift, Butler, Enomoto, and Yagawa Are Not Prior Art**

Applicants' specification, on page 2 lines 1-7, claims priority to U.S. App. No. 08/770,238 (now US 5,991,799), filed on December 20, 1996, and to U.S. Provisional App. No. 60/047,809, filed on May 16, 1997. All pending claims are fully supported by either or both of the parent documents, and therefore, each claim has a priority date of either December 20, 1996, or May 16, 1997. Although support for the claims may be found throughout the parent documents, to aid the Office and in the interest of moving prosecution forward, Applicants provide at least one example of support for each claim in Appendix A attached hereto.

Claims 11, 20, 25, 26-30, 35, and 36 have an effective filing date of at least May 16, 1997, based on the support for these claims in the '809 application and the '799 patent. Claims 1, 2, 7, 8, 10, 13-16, 18, 19, 21, 23, 24, and 31-34 have an effective filing date of December 20, 1996, based on the on the support for these claims in the '799 patent.

The earliest prior art date of Butler is July 29, 1997; the earliest prior date of Enomoto is August, 1, 1997; and the earliest prior date of Yagawa is December 23, 1997. Butler, Enomoto, and Yagawa fail to qualify as prior art to any pending claim, because each has a prior art date after both effective filing dates of December 20, 1996, and May 16, 1997. The rejection of each pending claim relies on at least one of the disqualified references above. Because the office action cannot rely on the disqualified references for support, the office action fails to put forth a prima facie case of obviousness, and because the Office does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Further, the earliest prior art date of Kikinis is March 27, 1997; and the earliest prior date of Thrift is October 3, 1997. Kikinis and Thrift fail to qualify as prior art for claims 1, 2, 7, 8, 10, 13-16, 18, 19, 21, 23, 24, and 31-34, which have an effective filing date of December 20, 1996. The rejections to each of these claims additionally rely on either or both of the disqualified Thrift and Kikinis references, and therefore, the office action fails to put forth a prima facie case of obviousness against these claims for this additional reason.

In view of the deficiencies in the prior art dates of the references above, Applicants submit that all claims are now in condition for allowance.

Applicants further submit that should a new office action be issued, and if it includes claim rejections, the new office action may not be made final. See MPEP 706.07(a), Final Rejection, When Proper on Second Action.

### **CONCLUSION**

If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account 19-0733 in the appropriate amount.

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

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## APPENDIX A

Support for each claim may be found as follows:

- claims 1 and 16:
  - ‘799 patent, fig. 1, col. 4 ll. 14-22; ‘809 application, pp. 21-30, 152 -154, 478-481 (disclosing “a controller,” “a television interface,” “an interactive information interface,” “a remote control,” and “data memory”);
  - ‘799 patent, col. 9 line 63 to col. 10 line 62; ‘809 application, p. 19, 27, 53-54, 63, 80, 260 (disclosing “user preferences ... , wherein said interactive and said television portions are formatted according to said user preferences”);
  - ‘799 patent, col. 6 ll. 31-61, col. 14 ll. 12-17; ‘809 application, pp. 21-32 (disclosing “said controller is configured to obtain said interactive information in response to said user input received from the remote control and television information in response to said user input”);
  - ‘799 patent, col. 6 ll. 16-26; ‘809 application, pp. 1-5, 12, 49, 54, 62 (disclosing “said controller being further configured to generate said image representative signal such that corresponding presented imagery includes an interactive portion containing said interactive information and a television portion containing said television information”);
  - ‘799 patent, col. 3 ll. 26-35, col. 9 ll. 19-28, col. 13 ll. 40-48, col. 14 ll. 7-29; ‘809 application, pp. 1-5, 12, 49, 54, 56, 62, 75-76 (disclosing “wherein said interactive portion is presented as an elongated horizontal portion encompassing less than half of a television screen at an edge of said television portion and does not obscure said television portion, and wherein said television portion is arranged to encompass more than half of the television screen.”)
- claim 2: ‘799 patent, col. 11 ll. 4-29; ‘809 application, pp. 20, 62-63 “HTML via VBI” and “Autojump,” and 81-82.
- claim 7: ‘799 patent, col. 13 ll. 40-48; ‘809 application, pp. 1-4, 5, 12, 49, 54, 62, 75-76.

- claims 8 and 19: ‘799 patent, col. 7 ll. 10-25, col. 11 ll. 3-15; ‘809 application, pp. 5, 12, 53-54.
- claims 10 and 21: ‘799 patent, col. 13 ll. 40-48, col. 14 ll. 7-29; ‘809 application, pp. 3-4, 62.
- claims 11 and 20: ‘809 application, pp. 21, 54, 160.
- claims 13 and 18: ‘799 patent, col. 14 ll. 24-29; ‘809 application, pp. 53-54.
- claims 14 and 23: ‘799 patent, col. 13 ll. 29-39; ‘809 application, pp. 12, 62.
- claims 15 and 24: ‘799 patent, col. 11 ll. 4-29; ‘809 application, pp. 20, 62-63, and 81-82.
- claims 25 and 28:
  - ‘799 patent, fig. 1, col. 4 ll. 14-22; ‘809 application, pp. 21-30, 152 -154, 478-481 (disclosing “a controller,” “a television interface,” “an interactive information interface,” “a remote control,” and “data memory”);
  - ‘799 patent, col. 9 line 63 to col. 10 line 62; ‘809 application, p. 19, 27, 53-54, 63, 80, 260 (disclosing “user preferences ... , wherein said interactive and said television portions are formatted according to said user preferences”);
  - ‘799 patent, col. 6 ll. 31-61, col. 14 ll. 12-17; ‘809 application, pp. 21-32 (disclosing “said controller is configured to obtain said interactive information in response to said user input received from the remote control and television information in response to said user input”);
  - ‘799 patent, col. 6 ll. 16-26; ‘809 application, pp. 1-5, 12, 49, 54, 62 (disclosing “said controller being further configured to generate said image representative signal such that corresponding presented imagery includes an interactive portion containing said interactive information and a television portion containing said television information”);
  - ‘809 Application, pp. 1-12, 62, 87 (disclosing “wherein said interactive information is presented in a translucent overlay region over the television portion, wherein the translucent overlay region does not substantially obscure the television portion.”);
- claims 26: ‘809 Application, pp. 1-12, 15, 62;
- claims 27 and 30: ‘809 Application, pp. 4, 9;

- claim 29, ‘809 Application, pp. 1, 128, 356;
- claims 31-36: ‘799 patent, col. 13 ll. 40-48, col. ll. 49-67; ‘809 application, p. 63 “Autojump”;
- claim 37, ‘809 Application, pp. 4, 9, 10; and
- claim 38, ‘809 Application, pp. 60-63.